

REMARKS

Applicant respectfully submits that the foregoing amendments are sufficient to place the application in a condition for allowance.

Claim Rejections under 35 U.S.C. § 112

The Examiner has rejected Claims 7 and 8, and all other claims dependent on either of them along with Claim 1, for indefiniteness on the basis that the preamble of those claims is directed to a closure while the body of those claims positively introduces the projection structure of the container. Applicant respectfully traverses this rejection based on the amendment to Claims 7 and 8 set forth herein, which overcomes the rejection in no longer setting forth the container structure as a positively recited element.

Claim Rejections under 35 U.S.C. §§ 102 and 103:

In the final Office Action, the Examiner has withdrawn all of the previous bases for rejection of the claims and now asserts that (i) Claims 1 and 25 are anticipated by Molinaro, U.S. Patent No. 5,480,045; (ii) Claims 1-6, 22 and 25 are obvious in light of the combination of Kern, U.S. Patent No. 4,448,319 with Sander, U.S. Patent No. 5,487,481; (iii) Claim 9 is obvious in light of the prior art as applied to Claim 1 or 25 in combination with Csaszar, U.S. Patent No. 4,343,408; (iv) Claims 11, 13 and 14 are obvious in light of the prior art as applied to Claim 1 or 25 in combination with Montgomery, U.S. Patent No. 5,379,910; (v) Claims 17 and 19 are

obvious in light of the prior art as applied to Claim 1 or 25 in combination with Repp et al., U.S. Patent No. 5,593,055; and (vi) Claims 1, 21 and 23-25 are obvious in light of the combination of Kern and Julian, U.S. Patent No. 5,056,675. The Examiner has indicated that Claims 7, 8, 10, 12, 15, 16, 18 and 20 (as dependent from Claims 1 and 25) are allowable over the prior art and would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112 and to include all of the limitations of base Claims 7 or 8 and any intervening claims.

As dependent from Claims 1 and 25 as amended herein, it is respectfully submitted that all claims are now in a condition for allowance, as Claims 1 and 25 now incorporate the limitations of Claims 21, 23 and 24 to require:

"... a tamper indicating ring connected to said depending skirt by a frangible element; wherein said tamper indicating ring includes at least one arcuate projection extending around at least a portion of said tamper indicating ring arranged for registration with a container neck portion on which said closure is positioned and said closure includes at least one nonremovable member breakably attached to said tamper-indicating ring which cooperates with at least one said arcuate projection to assist in breaking said tamper indicating ring during removal of said closure from said container neck.; and wherein at least one said arcuate projection is held in place by an annular locking flange on said container neck as said member is pulled away from said arcuate projection by twist-off removal of said annular depending skirt to cause said tamper indicating ring to break at a weakened area as said member pulls said tamper indicating ring upward to cause breakage of said frangible elements and fracture of said weakened area by separation of said portion of said tamper indicating ring attached to said member from said portion of said tamper indicating ring attached to said arcuate projection."

It is believed that this amendment now places Claims 1 and 25 and all remaining claims (as dependent therefrom) in a condition for allowance, as the only basis for rejection of Claims

23 and 24 was the combination of Kern and Julian, where Julian was cited as disclosing the foregoing limitation added to Claims 1 and 25. However, Julian does not disclose a tamper indicating band having the claimed "*arcuate projection*", but instead teaches only ratchet teeth **52** that do not allow rupture of the tamper indicating band in a manner equivalent to the claimed requirement that "*said arcuate projection is held in place by an **annular locking flange** on said container neck as said member is pulled **away** from said arcuate projection by twist-off removal of said annular depending skirt to cause said tamper indicating ring to break at a weakened area as said member pulls said tamper indicating ring **upward** to cause breakage of said frangible elements and fracture of said weakened area by **separation** of said portion of said tamper indicating ring attached to said member **from** said portion of said tamper indicating ring attached to said arcuate projection*".

Instead of allowing movement of the tamper indicating ring "***upward to cause breakage of said frangible elements and fracture of said weakened area***" as required by the instant claims, the ratchet teeth **52** cause the tamper evident band to stay stationary as breakage of the band occurs by circumferential (and not upward) movement to sever frangible elements **34/34'** and **50/50'** as shown in Figs. 4-7 of Julian:

Likewise, in the unthreading direction, the stop surfaces **54** of the band ratchet teeth **52** will engage the stop surfaces **60** of the container neck ratchet teeth **58** *to **prevent further rotation*** of the tamper indicating band **30** relative to the container **24**.... Referring to Fig. 4 as the cap **12** is further turned in the unthreading direction after the band ratchet teeth **52** have engaged the container neck ratchet teeth **58**, the band **30** *will remain stationary* with respect to the container neck, but the cap will **turn** relative to the band ... until the axially extending frangible webs **34** will become fractured as shown at **34'**.... Continuing rotation in the direction of the

arrow as shown in Fig. 5 will further flex the permanent flexible web 36 so that [t]he circumferentially extending frangible webs 50 will now be put under fracturing tension so that additional **rotation** of the cap in the direction of the arrow as shown in Fig. 6 will fracture these webs as shown at 50'. (See Julian; at column 5, lines 5-68; and at Figs.4-7.)

As with the prior withdrawn rejection of these claims as based on Beck, U.S. Patent No. 5,215,204, permanent flexible web 36 in Julian does not assist in breaking tamper indicating ring 30 by pulling the tamper indicating ring upward. This distinction over Beck as drawn in Applicant's response to the initial Office Action was accepted as a basis for withdrawing the rejection, and applies equally to the present rejection based on Julian.

For the foregoing reasons, in addition to the reasons set forth in Applicant's response to the initial Office Action for distinguishing over the prior art of record, the currently cited references cannot anticipate¹ or render obvious² Claims 1 or 25 or any other pending claim of the

¹ See MPEP § 2131 (citing In re Bond, 910 F.2d 831, 832 (Fed.Cir. 1990))(for a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be **identically shown** in that reference, and the elements must be arranged as in the claim under review); In re Paulsen, 30 F.3d 1475, 1478-79 (Fed.Cir. 1994)(to serve as the basis for a 35 U.S.C. § 102 rejection, the relied upon reference must contain **all** the limitations of the rejected claim); PPG Industries v. Guardian Industries Corp., 75 F.3d 1558, 1566, 37 USPQ.2d 1618, 1624 (Fed.Cir. 1996)("[t]o anticipate a claim [under 35 U.S.C. § 102] a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter").

² See Motorola v. Interdigital Technology Corp., 121 F.3d 1461, 1471, 43 USPQ.2d 1481, 1489 (Fed.Cir. 1997)("[i]n order to render a claimed apparatus or method obvious, the prior art must **enable** one skilled in the art to **make and use** the apparatus or method")(citing Beckman Instruments, Inc. v. Productukter AB, 892 F.2d 1547, 1551, 13 USPQ.2d 1301, 1304 (Fed.Cir. 1989)). See W.L. Gore & Associates v. Garlock, Inc., 721 F.2d 1540, 1552-53 (Fed.Cir. 1983)("proceeding **contrary** to [i.e., "**teaching away**" from] the accepted wisdom in the art . . . is "**strong evidence of nonobviousness**"); Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1578-80, 42 USPQ.2d 1378, 1383-84 (Fed.Cir. 1997)(same). See also In re Gordon, 733

present application (which all depend therefrom) as amended herein,³ because they are all based in whole or in part on the improper combination of these references.⁴ Thus, the Examiner's burden of establishing a *prima facie* case of unpatentability has not been made out based on the art of record, rendering the pending claims allowable as a matter of law.⁵

F.2d 900, 901-02, 221 USPQ 1125 (Fed.Cir. 1984)(reversing an obviousness rejection sustained by the Board of Appeals and Interferences on the basis that "[the relied-upon reference] **teaches away from the board's proposed modification**")(alteration in original); In re Fine, 837 F.2d 1071, 1074-76, 5 USPQ.2d 1596 (Fed.Cir. 1988)(same). See MPEP § 2143.01 ("if the proposed modification or combination of the prior art would **change the principle of operation** of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious"). See also In re Gordon, *supra*, 733 F.2d at 901-02 (reversing an obviousness rejection sustained by the Board of Appeals and Interferences on the basis that "if [the prior art reference were modified in the manner suggested] it would be rendered inoperable for its intended purpose. . . . In effect, [the relied-upon reference] **teaches away from the board's proposed modification**")(alteration in original).

³ See In re Fine, *supra*, 837 F.2d at 1076 (dependent claims are allowable if independent claims from which they depend are allowable).

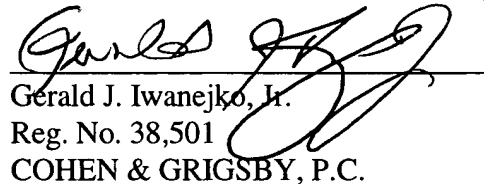
⁴ See MPEP § 2141.01(a)("in order to rely on a reference as a basis for rejection . . . the reference must . . . be in the field of applicant's endeavor or . . . reasonably pertinent to the **problem** with which the inventor was concerned"); see also MPEP § 904.01(c)(determination of analogous art "depends on the necessary **essential function** or utility of the subject matter **covered by the claims**"). See also Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, 21 F.3d 1068, 1071-72 30 USPQ.2d 1377, 1379-80 (Fed. Cir. 1994)(holding relied-upon references did not support rejection of obviousness because the trial court "identified no reference that taught or suggested that [the elements of the claims] might be **adapted** to the [claimed combination] . . . when the patented invention is made by combining **known** components to achieve a **new** system, the prior art must provide a suggestion or motivation to make such a combination")(alteration in original).

⁵ See MPEP § 2142 ("[w]ith regard to rejections under 35 U.S.C. § 103, **the examiner must provide evidence** which as a whole shows . . . [that] the reference teachings establish a *prima facie* case of obviousness"); MPEP § 2143.01 ("a statement that modifications of the prior art to meet the claimed invention would have been '**well within the ordinary skill of the art**' at the time the claimed invention was made . . . is **not** sufficient to establish a *prima facie* case of obviousness without some objective **reason** to combine teachings of the references")(citing Ex parte Levengood,

For the foregoing reasons, reconsideration and allowance of Claims 1-20, 22 and 25 as amended herein is respectfully requested.

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28 USPQ.2d 1300)(Bd.Pat.App.&Inter. 1993)("As adapted to *ex parte* procedure, Graham [v. John Deere Co.], 383 U.S. 1, 148 USPQ 459 (1966)) has been interpreted as continuing to place the burden of proof on the Patent Office which requires it to produce the factual basis for [its] rejection of an application under 35 U.S.C. § 102 or 103. . . . [A]n examiner **cannot** establish obviousness by locating references which describe various aspects of a patent applicant's invention **without also providing evidence of the motivating force** which would impel one skilled in the art to do what the patent applicant has done" (alteration in original))(also citing In re Fine, *supra*, 837 F.2d at 1074-76 ("[t]he relied-upon references] disclose at most, that one skilled in the art might find it **obvious to try** the claimed invention. But whether a particular combination might be 'obvious to try' is **not** a legitimate test of patentability. The Examiner relies on hindsight to reach his obviousness determination. But this court has said '[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher'")(citing W.L. Gore & Associates v. Garlock, Inc., *supra*). See also In re Laskowski, 871 F.2d 115, 116, 10 USPQ.2d 1397, 1398 (Fed.Cir. 1989)(reversing Board of Appeals and Interferences affirmance of rejection based on obviousness since "the mere fact that the prior art **could** be so modified would **not** [make] the modification obvious unless the prior art suggested the **desirability** of the modification"); In re Fritch, 972 F.2d 1260, 1265-66, 23 USPQ.2d 1780 (Fed.Cir. 1992)(same). See also In Re Bond, 910 F.2d 831, 834-35, 15 USPQ.2d 1566 (Fed.Cir. 1990) (rejecting a Board of Appeals and Interferences finding of obviousness where "critical differences exist between the claimed invention and the [relied-upon] prior art")(alteration in original).